



FEB 19 2002

In re

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:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 1, 11, 22 and 39 of the morning section and questions 1, 18 and 41 of the afternoon section of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On June 11, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and

37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the

answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 6, 11, 22 and 39 and afternoon questions 1, 18 and 41. Petitioner's arguments for these questions, except morning question 22, are addressed individually below. All responses were accepted for morning question 22 and petitioner's score of 67 already reflects credit given for that question. Also, although petitioner labeled the first question petitioned as morning question 1, petitioner's argument relates to morning question number 6 and has been treated accordingly. Petitioner correctly answered morning question 1, so petitioner could receive no benefit from a response to morning question 1. Petitioner's score of 67 already reflects petitioner's correct response to morning question 1.

Morning question 6 reads as follows: (Again, as noted above, although petitioner labeled the first question petitioned as morning question 1, petitioner's argument relates to morning question number 6 and has been treated accordingly. Petitioner correctly answered morning question 1, so petitioner could receive no benefit from a response to morning question 1.)

Please answer questions 5 and 6 based on the following information. A patent issued to Joe Inventor on July 25, 2000 based on an application filed in January 1999. Larry Practitioner was the registered practitioner of record in the application, and all correspondence from the USPTO during prosecution was directed to Larry at his then-current address. At the time he paid the issue fee, Larry designated a "fee address" for payment of maintenance fees. Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Larry did not, however, file a change of correspondence address in the patent file. An assignment of all rights in the patent from Joe Inventor to Big Corporation was made September 5, 2000 and was recorded in the USPTO on September 14, 2000.

6. Under standard USPTO practice and procedure, where will the USPTO send a communication for Big Corporation concerning a request for reexamination involving the patent?

(A) Joe Inventor's address as indicated on the inventor's declaration, unless a change of address had been filed for Mr. Inventor.

(B) Larry Practitioner's address prior to September 2000.

(C) Larry Practitioner's address subsequent to September 1, 2000.

(D) The fee address designated by Larry Practitioner at the time he paid the issue fee.

(E) The address of the assignee as indicated on the assignment recorded in the USPTO.

The model answer is selection (C).

See, e.g., 37 C.F.R. § 1.33(c); MPEP §§ 2222 and 403.

Petitioner argues that answer (B) is correct. Petitioner contends that since practitioner failed to file a change of address it is reasonable to conclude that any correspondence sent to the practitioner would be sent to his address prior to his move.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that since practitioner failed to file a change of address it is reasonable to conclude that any correspondence sent to the practitioner would be sent to his address prior to his move, Larry moved his office on September 1, 2000, and notified the Office of Enrollment and Discipline of his new address in accordance with 37 C.F.R. § 10.11. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 11 reads as follows:

11. Registered practitioner Ethel prepares a utility patent application (not a CPA) for inventor Fred, using her only copy of a published article, "Engineering Design," published June 8, 1995, to draft the application. Thereafter, Ethel accidentally runs the copy of the article through her paper shredder. Ethel duly files the application in the USPTO on May 29, 1999. The examiner sends Ethel a non-final Office action dated December 7, 2000, setting a three-month period for reply, including a rejection of claim 1 and a requirement for information under 37 CFR § 1.105 requiring her to submit a copy of the article, "Engineering Design." Which of the following will properly be accepted by the USPTO as a complete reply to the requirement for information?

(A) An information disclosure statement, filed by Ethel on Monday, January 15, 2001, that complies with the provisions of 37 CFR § 1.98, listing a foreign patent, and stating that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office less than three months prior to the filing of the information disclosure statement.

(B) A statement filed by Ethel on Wednesday, March 7, 2001, stating that Ethel is not an individual identified under 37 CFR § 1.56(c).

(C) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one-month extension, that states that the information required to be submitted is not readily available to the party from which it was requested.

(D) A statement filed by Ethel on Thursday, March 8, 2001, with the appropriate petition and fee for a one month extension, which states that Ethel has a good faith belief that the information required is not material to patentability.

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.105(a)(3) (effective November 7, 2000), "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000), and 37 CFR § 1.136(a)(1). (C) is correct pursuant to 37 CFR § 1.105(a)(3). (A) is incorrect because it is not responsive to the requirement for information. (B) is incorrect because "each attorney or agent who prepares or prosecutes the application," is identified an individual under 37 CFR § 1.56(c). (D) is incorrect because information used to draft an application may be required under 37 CFR § 1.105(a)(1)(iv). (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that the terms "readily" and "party" are not clearly defined and therefore it is logical to infer that answer (C) is incorrect as well.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the terms "readily" and "party" are not clearly defined and therefore it is logical to infer that answer (C) is incorrect as well, (C) is correct pursuant to 37 CFR § 1.105(a)(3) according to the explicit materials in the Federal Register notice promulgating this rule. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Which of the following is/are required to be included in a request for reexamination submitted by a person other than the patent owner on January 12, 2001?

(A) A statement pointing out each substantial question of patentability based on the arguments stated by the examiner in the first Office action.

(B) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112.

(C) A copy of the entire patent including the front face, drawings, and specification/claims, in double column format on single-sided sheets, for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent.

(D) A certification that a copy of the request has been served in its entirety on "the patent owner at the address as provided for in § 1.33(c)," without indicating the name and address of the party served.

(E) None of the above.

The model answer is selection (C).

37 CFR § 1.510(b) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54649 (September 8, 2000). As stated in 65 FR at 54649, middle column, "Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only." Thus (C) is correct. (A) is incorrect because 37 CFR § 1.510(b)(1) requires that each substantial new question of patentability be based on prior patents and publications. (B) is incorrect because the statement in (B) is required by 37 CFR § 1.293(b), not by 37 CFR § 1.510(b). (D) is incorrect because under 37 CFR § 1.510(b)(5), the name and address of the party served must be indicated if the request is by a person other than the patent owner.

Petitioner argues that answer (E) is correct. Petitioner contends that the confusion between the MPEP, indicating single column format, and the double column format in answer (C) should make answer (C) incorrect leaving (E) as the appropriate answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the confusion between the MPEP, indicating single column format, and the double column format in answer (C) should make answer (C) incorrect leaving (E) as the appropriate answer, As stated in 65 FR at 54649, middle column, "Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only." As to the purported confusion, the instructions explicitly recite "The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register." The Federal Register notice clearly modified the MPEP practice. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following is in accord with proper USPTO practice and procedure?

(A) Upon request to convert a provisional application to a nonprovisional utility application, the nonprovisional application is accorded a filing date as of the date on which the request to convert was filed, but the original filing date of the provisional application is preserved.

(B) If a provisional application does not have a claim as filed, and a claim is not filed with a timely request to convert the provisional application to a nonprovisional utility application, the Office will notify the applicant and set a time period for submitting a claim for examination.

(C) A provisional application filed in November 2000 is entitled to the right of priority under 35 U.S.C. § 119 of a copending utility application for patent filed in Great Britain in January 2000.

(D) A request filed in January 2001, to convert a provisional application filed in the USPTO in April 2000, to a nonprovisional utility application is timely if filed after the abandonment of the provisional application, i.e., after the pendency of the provisional application, but within twelve months of the filing date of the provisional application provided no petition to revive has been filed and granted.

(E) A nonprovisional utility application filed under the provisions of 37 CFR § 1.53(b) in January 2001, and claiming the benefit of the earlier filing date of a provisional application must be filed during the pendency of the provisional application.

The model answer is selection (B).

37 C.F.R. § 1.53(c)(3) requires the presence of a claim to convert a provisional application to a nonprovisional application. The Office will set a time period within which a claim must be submitted for the Office to grant the request if the provisional application does not have a claim and a claim is not filed with the request. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50099, middle column, (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (A) is not the most correct answer. 37 C.F.R. § 1.53(c)(3). There is only one application, and that application has a single filing date, the filing date of the provisional application. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50099, left column (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. 35 U.S.C. § 111(b)(7); 37 C.F.R. § 1.53(c)(4). (D) is not the most correct answer. 37 C.F.R. §

1.53(c)(3) requires that any request to convert a provisional application to a nonprovisional application be filed prior to abandonment of the provisional application. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. The provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that answer (E) is correct. Petitioner contends that a non-provisional application filed over a year subsequent to the filing of a provisional application is filed subsequent to the pendency of the provisional application, consistent with answer (E).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that a non-provisional application filed over a year subsequent to the filing of a provisional application is filed subsequent to the pendency of the provisional application, consistent with answer (E), the provisions of 35 U.S.C. § 119(e)(2) were amended to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50098, left and middle columns (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). The fact that the petitioner can envision a hypothetical situation in which a non-provisional cannot claim the benefit of a provisional application coincides with the lapse of a provisional pendency does not show that the latter causes the former, merely that coincidence may occur. Accordingly, model answer (B) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 18 reads as follows:

18. Which of the following is not required in order for a foreign application that has matured into a foreign patent to qualify as a reference under 35 U.S.C. § 102(d)?

(A) The foreign application must have actually been published before the filing of an application in the United States, but the patent rights granted need not be enforceable.

(B) The foreign application must be filed more than 12 months before the effective filing date of the United States application.

(C) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.

(D) The foreign application must have actually issued as a patent or inventor's certificate before the filing of an application in the United States. It need not be published but the patent rights granted must be enforceable.

(E) The same invention must be involved.

The model answer is selection (A).

35 U.S.C. § 102(d). The foreign application need not be published, but the patent rights granted must be enforceable. MPEP § 706.02(e). (B), (C), (D) and (E) are required by 35 U.S.C. § 102(d).

Petitioner argues that answer (C) is correct. Petitioner contends that answer (C)'s assertion that the foreign and domestic applicant names must be the same is incorrect.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (C)'s assertion that the foreign and domestic applicant names must be the same is incorrect, (C) actually asserts that the foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns. The relevant portion of 35 U.S.C. § 102(d) states "the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country." Accordingly, model answer (A) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. A nonprovisional patent application was filed on December 1, 2000, including a patent application declaration and an application data sheet. The application data sheet that includes the applicant's full name, residence, mailing address, and citizenship. The application data sheet does not include any foreign priority information. Which of the following must be identified in the declaration?

(A) Applicant's mailing address.

(B) Applicant's citizenship.

(C) Any foreign application for patent for which a claim for priority is made by Applicant pursuant to 37 CFR § 1.55.

(D) (B) and (C).

(E) All of the above.

(C) or (D) are accepted as correct answers.

37 CFR § 1.76(d) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54624-25 (Sept. 8, 2000); and 37 CFR § 1.63 (effective November 7, 2000). Under 37 CFR § 1.63(c)(1), Applicant's mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect. The foreign priority information must be included in the declaration because it was not included in the application data sheet. 37 CFR § 1.63(c)(2). Thus, (C) is correct. Applicant's citizenship in (B) must be included in the declaration under 37 CFR § 1.63(a)(3), if "applicant" in (B) is construed as a person or party, e.g., 37 CFR § 1.42, other than the inventor, and no exception is made for citizenship under 37 CFR § 1.63(c). In the latter instance, where both (B) and (C) are correct, and (D) is the most correct answer because it is inclusive of (B) and (C). (B) alone is not accepted because the foreign priority document must be included in the declaration. (E) is incorrect because (A) is incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that all answers can be correct in light of the confusing use of the word "must".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that all answers can be correct in light of the confusing use of the word "must", under 37 CFR § 1.63(c)(1), Applicant's mailing address need not be identified in the declaration if it is included in the application data sheet. Thus, (A) is incorrect, irrespective of any confusion around the word "must". Accordingly, model answers (C) and (D) are correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy